

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.:	10/568,201	Confirmation No. 7816
Applicants:	Miles et al.	
Filed:	September 20, 2006	
Title:	BONE SUBSTITUTE MATERIAL	
Art Unit:	1794	
Examiner:	Vo, Hai	
Docket No.:	107687.00013	

**Mail Stop: Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Dear Sir

In response to the Restriction Requirement mailed on April 10, 2009, Applicants elect the invention of Group II, claims 14-19 and 40-51, with traverse. The pending application is an application under 35 U.S.C. 371, which requires PCT Rule 13.1 and 13.2 to be applied. In the International Search Report dated December 3, 2004, no lack of unity of invention was found. Indeed, the International Search Authority identified a single reference, WO 03/026714, which was applied to claims 1-8, 10-14, 15, 17-19, 20, 22, 25, 26-28, 30-39 and 51, which includes claims in groups I and II. As such, a search of the inventions of groups I and II has already been performed. The absence of any indication of a lack of unity of invention in the International Search Report and the performance of a search by the International Search Authority clearly demonstrates that the claims relate to a single general inventive concept under PCT Rule 13.1 and do not lack the same or corresponding special technical feature under PCT Rule 13.2.

Furthermore, the reasons provided by the Examiner for asserting lack of unity of invention fail to show a lack of unity of invention. Indeed, the Examiner admits that all of the groups are directed to an article and a process useful in the general field of bone substitute material. Furthermore, unity of invention should be considered in accordance with the PCT

International Search and Preliminary Examination Guidelines, per MPEP 1893.03(d). Paragraph 10.3 of those guidelines is instructive:

10.03 Lack of unity of invention may be directly evident “a priori,” that is, before considering the claims in relation to any prior art, or may only become apparent “a posteriori,” that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity a priori as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present a priori as A is common to both claims. However, if it can be established that A is known, there is lack of unity a posteriori, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

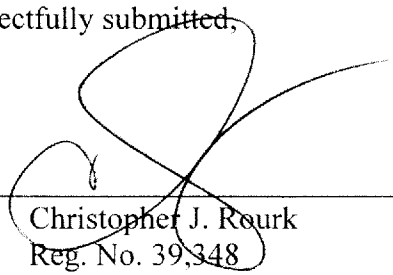
The reasons for finding lack of unity of invention set forth by the Examiner are contrary to these guidelines, as they essentially state that claims A + X and A + Y lack unity of invention because one group of claims includes limitation X and another group of claims includes limitation Y, whereas the PCT guidelines state that unity of invention is present a priori. The test for finding a lack of unity of invention is not to find claim elements that are not common to all claims, but to show that all claims lack a common element.

In that regard, there is a common element to all claims. Consider claim 1, which includes “sintering the ceramic slip to form a bone substitute material that is approximately a positive image of the distorted foam material.” Likewise, claim 14 includes “a porous sintered ceramic having approximately the form of a positive image of an open celled foam material.” Claim 20 includes “sintering the ceramic clip to form a granular bone substitute material in which the granules are approximately positive images of the pieces of foam material.” Claim 40 includes “a multiplicity of granules of a porous sintered ceramic, each granule having approximately the form of a positive image of an open celled foam material.” Claim 51 includes “a bone substitute material of a porous sintered ceramic having approximately the form of a positive image of an open celled foam material.” Claim 52 includes “a bone substitute material that is approximately the in the form of a positive image of an open celled foam material.” This identification rebuts the assertion that there is no common feature in the claims that is not a technical feature that defines a contribution over the prior art, as the common feature to all claims is missing in the art relied upon by the Examiner. As such, withdrawal of the restriction requirement is respectfully requested.

Dated: May 11, 2009

Respectfully submitted,

By: \_\_\_\_\_

  
Christopher J. Rourke  
Reg. No. 39,348

Jackson Walker L.L.P.  
901 Main Street  
Suite 6000  
Dallas, Texas 75202  
Direct: 214-953-5990  
Fax: 214-661-6604  
Email: [crouk@jw.com](mailto:crouk@jw.com)